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alia in the specification on page 25, line 28 to page 26, line 32, page 32, line 34 to page 33, line 4, page 58, lines 1-20, and page 3, lines 20-21. Applicants contend that this amendment does not involve any issue of new matter. Accordingly, claims 94-96 and 98-110 will be pending upon entry of this amendment.

New claim 102

Applicants have hereinabove added new claim 102 which is drawn to an antibody which binds to PSMA. Applicants maintain that this claim is not anticipated by Feng et al. Applicants respectfully direct the Examiner's attention to MPEP 2121.01 which states:

In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention "not novel" or "anticipated" within section 102, the stated test is whether a reference contains an enabling disclosure...A reference contains an "enabling disclosure" if the public was in possession of the claimed invention before the date of invention. Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his or her own knowledge to make the claimed invention.

Applicants contend that Feng et al is not an enabling disclosure. In order to perform the experiments recited in Feng et al to purify the 7E11-C5 Prostate Carcinoma-Associated Antigen, one skilled in the art would require the 7E11-C5 antibody. The antibody would be needed in order to bind to and thus, identify the antigen. Without this antibody, one would not be able to identify the antigen and thus, would not be able to determine whether the antibody did in fact bind to PSMA. Accordingly, Feng et al could not anticipate applicants claimed invention. Applicants contend that the 7E11-C5 antibody was not available to the public prior to applicants' effective filing date, i.e November 5, 1992. In support, applicants attach hereto declarations signed by Julius S. Horoszewicz and John Rodwell as **Exhibits 1-2**, respectively. Without the antibody, applicants contend that Feng is not an enabling disclosure and thus, should

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be removed as a reference. In support, applicants attach a declaration by Paul Kaladas as Exhibit 3. Accordingly, Feng does not anticipate applicants' claimed invention.

In addition, applicants contend that the disclosure of the specific 7E11-C5 antibody should not anticipate a genus claim. MPEP 2131.02 states that "a generic claim cannot be allowed to an applicant if the prior art discloses a species falling within the claimed genus." Applicants contend that the 7E11-C5 antibody does not fall within the claimed genus. The claimed genus is "an antibody which binds to PSMA." Feng does not suggest or disclose PSMA. Feng merely discloses an antibody, i.e. 7E11-C5, which recognizes a 100 kDa antigen. Feng does not specify the particular antigen to which it binds. Applicants contend that it was possible that 7E11-C5 could bind to many antigens. In particular, nothing in Feng indicates that the antigen might be PSMA. Accordingly, it was not known whether this antibody could bind to PSMA. Without knowing this, then it was not known whether this antibody was a member of applicants' claimed genus. Without knowing whether the antibody was a member of the genus, applicants contend that this antibody could not anticipate the genus. Applicants contend that these remarks obviate the above rejection and respectfully request that the Examiner reconsider and withdraw the rejection.

Rejection Under 35 U.S.C. §112, First Paragraph

In the May 12, 1998 Final Office Action, the Examiner rejected claim 93 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner stated that the specification as originally filed provides no support for an antibody which binds to a polypeptide

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having the biological activity of a prostate specific membrane antigen with the proviso that the antibody is not the 7E11-C5 monoclonal antibody.

The Examiner stated that any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Graselli*, 231 USPQ 393 (Bd. Pat. App. 1983) aff'd mem., 738 F.2d 453 (Fed. Cir. 1984).

In response, applicants respectfully traverse the Examiner's above rejection. Applicants contend that the specification's disclosure sufficiently supports the negative limitation. Nevertheless, without conceding the correctness of the Examiner's position but to expedite the prosecution of the subject application, applicants have hereinabove canceled claim 93 without prejudice and added new claim 102. Applicants contend that this amendment obviates the above rejection and respectfully request that the examiner reconsider and withdraw the rejection.

Allowed claims

Applicants acknowledge the Examiner's statement that claims 94-96, and 98-101 are allowed.

Summary

In view of the foregoing remarks, applicants respectfully request that the above grounds of objection and rejection be reconsidered and withdrawn and earnestly solicit allowance of the now pending claims.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone at the number provided below.

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No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

Albert Wai-Kit Chan

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Albert Wai-Kit Chan

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6/14/99

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